

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

Opinions of the Courts Below.

1. The District Court's decision, on the merits, dismissing the bill, dated January 18, 1943,¹ 40 Fed. Sup. 633.
2. The Court of Appeals' decision affirming the judgment below but on the ground of lack of jurisdiction and not on merits, dated July 10, 1944,² 144 Fed. (2d) 518.
3. The *Per Curiam* decision of this Court granting the Petition for a Writ of Certiorari and reversing the judgment below dated May 7, 1945.³ 65 U.S.P.Q. 237.
4. The Circuit Court of Appeals' decision, after the remanding of the case, affirming the judgment below dismissing the bill dated December 17, 1945.⁴ 152 Fed (2d) 665.

Jurisdiction.

The petition sets forth on page 2 the grounds on which jurisdiction is invoked and your petitioners particularly relied upon this Court's decision in the case of *Special Equipment Co. v. Conway P. Coe case*, 65, S.C. 741.

A Statement of the Case and Questions Involved.

The Petition sets forth, beginning with Page 3, a statement of the questions involved in this case, which is followed by a brief summary of the material facts necessary

-
1. Rec. p. 16.
 2. Rec. p. 129.
 3. Rec. p. 133.
 4. Rec. pp. 136-138.

to an understanding and the reasons relied upon for the allowance of the Writ. For sake of brevity they are not being here repeated.

Specification of Errors.

The Court of Appeals for the District of Columbia, in deciding the case, erred:

1. In ruling that while the plaintiffs were entitled to all of the inherent concomitants of the invention in view of the practice announced in the *Ellis* and *Prescott* cases,⁵ the applicant must be refused the claims since he had failed to show wherein the feature of the claim in question was necessary (indispensable) in the operation of the device claimed.

2. In conditioning the grant of a patent on a showing of necessity, notwithstanding the entire absence of law justifying such an extension of the requirements for the grant of a patent, and contrary to the ruling of this Court in the case of *Special Equipment Co. v. Coe*, *supra*, wherein it was held to be a reversible error to condition the grant of a patent on a showing of use of the invention.

3. In promulgating an additional requirement for the grant of a patent, namely, one directed to showing the necessity for a feature of the invention claimed, contrary to the Constitution and Statutes of the United States and the decision of this Court in the case of *Special Equipment Co. v. Coe supra*, which specifically ruled that the the Court of Appeals here was in error in independently conditioning the grant of a patent on a requirement not embraced by the Statutes.

4. In making a ruling as to the necessity of an invention embraced by the applicant's disclosure, in the absence

5. *Ellis v. Shaw*, 295 Fed. 1006.

Prescott et al. v. Swain, 39 Fed. (2d) 241.

of any evidence supporting such ruling, and in the presence of positive unrefuted testimony, of one skilled in the art, showing that the subject-matter of the claims sought was inherent in the applicant's structure and that the applicant's device fully responded to all of the structural and functional requirements of such claims.

5. In not, pursuant to the previous mandate of this Court, in which the judgment below was reversed, granting the relief under Section 4915 R. S. prayed for by the plaintiffs.

6. In refusing to grant the plaintiffs a patent, with claims 46, 48 and 49, merely on the independent unsupported observations of the Court contrary to the unequivocal testimony, of one conceded to be skilled in the art, clearly establishing that the subject-matter of the claims sought found complete response both structurally and functionally in the applicant's disclosure.

Summary of Argument.

The argument is summarized in the foregoing petition and in the following arguments.

ARGUMENT.

Introductory Matter Leading Up to the Decision of the Court of Appeals.

Your Petitioners made due application for Letters Patent, including among other claims, Claims 46, 48 and 49,⁶ specifically here in issue.

These claims, which are concededly directed to patentable subject-matter by the Commissioner of Patents, were refused to the applicant on the sole ground that they were not supported by the disclosure in the Schultz application,⁷ as conceded by the Commissioner of Patents. Upon the refusal of these claims by the Patent Office, the applicant, pursuant to Section 4915 of the Revised Statutes,⁸ filed a timely bill in the District Court for the District of Columbia and a trial *de novo* was had in that Court.

Consistent with the accepted practice, the plaintiffs in this suit adduced testimony of a person skilled in the art to show that the invention of the three claims that had been refused, was inherent in the disclosure of the application. This practice was approved by the Court of Appeals for the District of Columbia in *re Manson*, 45 Appellate D.C. 563.⁹

6. Rec. pp. 113-114.

7. Rec. pp. 20-21.

8. 35 U. S. C. A. 63.

9. "If those skilled in the art making the article from the information furnished in the original application would naturally so construct it that it would have the capability here in question, this capability must be regarded as inherent in the applicant's disclosure and a necessary characteristic of his invention whether originally known to or appreciated by him or not."

Similar rulings were made by the same Court in the cases of:

Rogers et al. v. Aikman, 277 Fed. 617.

Ellis v. Shaw, 295 Fed. 1006.

Prescott et al. v. Swain et al., 22 Fed. (2d) 1004,

These decisions were in conformity with the promulgations of the Supreme Court in the case of *Eibel Process Company v. Minnesota & Ontario Paper Company*, 261 U.S. 45, decided by Mr. Chief Justice Taft, (Pages 65 and 66).¹⁰

The Court of Appeals recognized the correctness of this practice since that Court in its decision of December 17, 1945, in the present case¹¹ held that plaintiff was entitled to all the inherent subject matter of his application.¹²

There also does not appear to be any question but what the plaintiffs below did sustain their burden of proof in presenting testimony of a person conceded to be one skilled in the art which established that the feature of Claims 46, 48 and 49 in question was inherent in the applicants' dis-

10. "This patent and its specifications were manifested to readers who were skilled in the art of paper making and versed in the use of the Fourdrinier machine. The evidence discloses that one, so skilled, had no difficulty, when his attention was called to their importance, in fixing the place of the disturbance and ripples to be removed, or in determining what was the substantial pitch needed to equalize the speeds of the stock and wire at that place."

11. Rec. pp. 136-138.

12. "In our view of the case we are not required to rule specifically on the effect of the plaintiffs' alleged previous contradiction of the function which he now seeks to have made a part of his application. Nevertheless, it may be said that in view of the *Ellis* and *Prescott* cases, *supra*, it is doubtful if the plaintiff in such an action should be denied the inherent concomitants of his invention even in the presence of a description that is inconsistent with the fact of operation. This would seem to be particularly true, where, as here, the language used appears to be primarily directed toward describing a mechanical arrangement of parts rather than the functioning of the device."

closure and in the unquestioned models, plaintiffs' Exhibits 7, 11 and 13, corresponding to Figures 1, 4 and 5 of the application.¹³ In fact, the District Court below makes specific findings of fact to that effect, namely, findings of fact, numbers 4 and 10, previously alluded to in the foregoing petition.¹⁴

Claim 48 was treated below as being representative of the three claims in suit. The structure involved comprises a fuse having a movable tube disposed between spaced terminals and provided with means for locking the fuse to at least one of the terminals. The feature of the claimed structure, that is specifically in controversy, is defined, for example, in the last clause of Claim 48 as follows:

"* * * and means for moving the fuse tube longitudinally relative to said one of said fuse terminals to release said locking means."

This element in reality takes the form of a spring associated with the vertical fuse tube so as to exert force on the tube, when the tube is blown, to move it downwardly. The point specifically raised is whether that spring assists in the release of the latch. With reference to Figure 4 of the drawings of the application,¹⁵ which illustrates one form of the three species shown and which may be taken representative, reveals that the spring 66 surrounds the fuse tube 50 and coacts through the roller pin 60 with the latching arm 61.

The District Court, in its Findings of Fact, and more particularly findings 4 and 10¹⁶ found that this spring "presumably did expedite to some degree the consumma-

13. Rec. p. 98.

14. Rec. pp. 14 and 16.

15. Rec. p. 99.

16. Rec. p. 14 and 16.

tion of the unlatching process" and that "such operation might be held to be inherent in the fuse structure."

Similarly the Court of Appeals in its decision¹⁷ found that the plaintiffs had shown that the fuse tube in being thus biased downwardly contributed to the releasing action. This court erred, however, in ruling at the conclusion of its decision, that "the force of the fuse tube's downward thrust is not clearly and positively necessary to the release of the latch, that is, release may be consummated without the assistance of the pressure operative in the expulsion of the fuse tube."

Thus the question is now narrowed down to one of whether the Court of Appeals, in the light of its findings, was justified in **conditioning the grant of the patent on a showing that the use of the spring to move the tube and release the locking or latching means was necessary.**

Question or Point I.

Your Petitioners, after a careful study of the authorities, have not been able to find a single instance where it has been held that as a prerequisite to a patent it must be first shown that a feature or element of a structure claimed is necessary or indispensable. Notwithstanding the absence of legal precedent the Court of Appeals has ruled that the spring associated with the fuse tube of the plaintiff's fuse, was not shown to be necessary and hence the applicant was not entitled to the claims in suit. It is true that if the spring were omitted the fuse tube might drop by gravity, but obviously that would defeat the very purpose of the invention which, as set forth in the objectives of the application,¹⁸ is to provide one wherein a ruptured fuse link could be quickly withdrawn by the quick release

17. Rec. p. 138.

18. Rec. p. 98.

of the latch and so that any ensuing arc within the fuse tube would be quickly extinguished. If the spring associated with the tube was dispensed with then the only motivating power available for the tube would be gravity and we would not have a structure wherein the arc could be quickly extinguished.

According to the disclosure of the application, it is hence clear that the spring is functionally an important element of the fuse combination, and the applicant should not have been required to make any further showing as to the indispensability of this feature as a condition to getting a patent.

The Court of Appeals in analyzing the situation, as is clear from its decision, reasoned that this tube must be biased by the spring and since this is so it follows that the tube, which bears against the latching arm, exerts a force on the latching arm thus assisting in the release of the latching means. This is all that the claims in issue require and the disclosure of your petitioners' application does fully respond to that, both structurally and functionally.

There does not appear to be any need to cite many decisions in support of the present petition since this Court in the very recent case of *Special Equipment Co. v. Coe*, *supra*, specifically ruled on a parallel situation. The law of that case is clearly applicable to the present one, and the Court of Appeals was in error in not following the promulgations of this Court in that case.

In that case the Court of Appeals for the District of Columbia, in refusing a patent, conditioned the grant on a showing of intention to use the invention, and this Court in reversing the Lower Court held that the Statutes passed by Congress, including Sections 4915 R.S. 4886 and 4884 were controlling and that the Court of Appeals was not warranted in requiring conditions for a grant other than

those specified in the Statutes. In making this ruling this Court said "We have no occasion to consider here whether a better rule governing the grant of patents could be devised than that prescribed by Congress, as this Court has interpreted it."¹⁹

Since the statutes in question do not require, as a condition to the grant of a patent, a showing of intention to use an invention on which a patent is sought, this Court there, properly reversed the decision of the Court of Appeals.

So, too, here the pertinent sections of the Revised Statutes, make no requirement as to conditioning the grant of a patent on a showing of necessity for any feature of the invention. The Patent Office has itself conceded that the claims here in issue are patentable fuse combination claims, and neither the District Court nor the Court of Appeals has in any way indicated that such claims do not involve a patentable combination. To say that the applicant Schultz discloses an invention called for in the claims found to be patentable by the Patent Office and then to refuse him a patent because he has not made a showing of necessity for the invention is certainly inconsistent with the spirit and intent of the Revised Statutes, including Sections 4915 and 4886.

The Defendant, Commissioner of Patents, has at no time urged that the spring means cooperable with the fuse tube, as required by the claims, is not necessary. On the contrary, the defendant readily concedes that the combination involving this spring means is a patentable combination, thus admitting that the invention has utility. Also at no time in the trial was any question raised as to the lack of necessity for or utility of the invention.

It is submitted that since the spring does have utility,

19. P. 746.

which has not been questioned, it is, in reality, a necessary component of the invention and the Court of Appeals was wholly in error in its independent ruling.

Question or Point II.

It has long been established, as admitted by the Court of Appeals in its decision, that the test of whether an invention is inherent in a disclosure of an application, can be met by the testimony of one skilled in the art, showing that he did construct from the disclosure a device having the capability in question. Mr. McNulty produced three models²⁰ of the three forms of the invention, shown in Figures 1, 4 and 5 of the application, and testified that he constructed them from the disclosure. There is no question about this fact since the District Court made Findings of Fact²¹ to that effect and those findings have not been disturbed by the Court of Appeals. **The District Court went a step further and found that the models which were successfully operated in open court were unquestioned.**²²

It is submitted that anyone skilled in the art operating these unquestioned models will readily perceive that they satisfy in every respect the requirements of the claims sought by your petitioners.

The defendant in this cause introduced no testimony or evidence other than the Patent Office record itself, which was unsworn to, to refute the testimony of this witness who was skilled in the art. The District Court properly, therefore, ruled that they were unquestioned models.

It is, therefore, clear that the Courts below in reaching

20. Exhibits Nos. 7, 11 and 13.

21. Rec. pp. 13-16 inclusive.

22. Rec. p. 16.

their ultimate decisions did so on their own independent efforts and without any evidence to justify the assumption that the skilled witness, who testified, was in error. The Lower Courts, in the absence of any testimony at all, made rulings directly contrary to the sworn-to statements of one skilled in the art.

It would seem that if Section 4915 of the Revised Statutes is to have any force and effect, the defendant would have to refute evidence of this character if any showing is to be made out justifying a denial of the patent. Instead the defendant here relied solely upon the unsworn-to actions of the Patent Office Staff and made no effort to produce in Court as witnesses, the members of that Staff so that they would be available in Court for purposes of cross-examination. The District Court after trial, had before it on the one hand the sworn-to testimony of a person skilled in the art showing the claims in suit were supported by the application disclosure, and on the other hand, the unsworn-to statements of the Patent Office Staff to the contrary. In submitting this testimony, the plaintiffs met their burden of proof, approved by the practice in case of *Ellis v. Shaw, supra*, and it thereupon became incumbent upon the defendant to submit testimony refuting this position if the defendant was to maintain the position adopted by the Patent Office in refusing the claims.

If the practice were otherwise, the very purpose and intent of section 4915 of the Revised Statutes would be defeated and there would be no advantage to having a trial *de novo* if, after the plaintiff has made out a case, the defendant is held to prevail solely on the unsworn-to and uncorroborated statements of the Patent Office Staff. Yet that is what happened here since the defendant submitted no testimony whatsoever and the decisions of the Lower

Courts were, of necessity, therefore based solely upon the findings of the Patent Office.

While it might be argued that the members of the Patent Office Staff are technically skilled, that in itself does not mean that they are necessarily skilled in the art to which this invention relates, or more particularly in the practical aspects of the invention. A Patent Office Examiner is frequently an engineering college graduate, but usually he has had no practical experience in the field of his Examination. Thus for the most part, the Examiners' decisions are based on theory rather than on actual conditions of use and operation.

Moreover, the Patent Office practice does not provide for the submission of any testimony as to the actual use and operation of an invention, such as was adduced here. Apparently this is one of the very reasons for the existence of Section 4915 of the Revised Statutes since the statute does afford an applicant for patent, who has been refused claims, an opportunity to present testimony of one skilled in the art as to the actual practical aspects and operation of the invention.

If testimony of this character can be offset by the mere unsworn-to statements of the Patent Office Staff, then there is not much use in presenting such testimony and the practice which has been approved by the present Court of Appeals in *Ellis v. Shaw* and *Prescott et al. v. Swain*, *supra*, decisions, would be of no avail.

It is a cardinal rule in our system of jurisprudence that if statements of a party are to be relied upon as evidence in a trial, that party or person, if available, should be called as a witness so that the opposing party may have an opportunity to cross-examine as to such statements. There is no reason for departing from this firmly entrenched rule of evidence in a suit of this character, in-

asmuch as such a suit is not a bureau proceeding but is an equity suit, subject to trial in the same manner as any other suit in open court.

If the plaintiffs had adopted the alternative remedy, provided for by Section 4911 of the Revised Statutes, then, of course, the decision of the Court of Customs and Patent Appeals would have been merely on the record; but having proceeded by way of Section 4915 R.S., the plaintiffs were certainly entitled to a trial *de novo* and to have the evidence that they adduced given due and proper weight in accordance with the prevailing rules of evidence.

The Court of Appeals did not give this testimony the weight to which it was entitled, but instead rendered a decision, contrary to the weight of the evidence, affirming the Patent Office ruling. In fact, the Court of Appeals ventured an independent and unsupported reason for its decision, namely, that plaintiffs below had not shown a necessity for the invention. This clearly constitutes a complete disregard of the plaintiffs' constitutional and statutory rights with respect to the granting of patents, and unless the decision is reversed, irreparable damage will ensue not only throughout this land but all foreign countries accorded reciprocity privileges regarding patents here.

Conclusion.

In conclusion, it is submitted that the decision of the Court of Appeals contravenes the very spirit and intent of the Revised Statutes, as well as is directly contrary to the principles of law promulgated by this Court in the recently decided case of *Special Equipment Co. v. Coe, supra*. To allow the present decision to stand unmodified defeats the purpose which Congress intended, in enacting Section 4915-R.S., and would be tantamount to approving

the conditioning of the grant of a patent on requirements not embraced by Statutory law.

The judgment below should therefore be reversed.

Respectfully submitted,

CHARLES F. MERONI,
CARLTON HILL,
Counsel for Petitioners.

WILLIAM A. SMITH, JR.,
Of Counsel.

Dated: Chicago, Illinois,

March 26, 1946.